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**REQUEST FOR RECONSIDERATION OF THE OFFICE'S DECISION
UNDER § 1.705(D) REGARDING PATENT TERM ADJUSTMENT**

Applicants : Guy A. Story, Jr., et al.
App. No. : 09/222,336
Filed : December 28, 1998
For : LICENSE MANAGEMENT FOR
DIGITAL CONTENT
Examiner : Retta, Yehdega
Conf. # : 3308

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Request for Reconsideration is submitted in response to the Decision on Request for Reconsideration of Patent Term Adjustment issued on August 15, 2012 (hereinafter, the "Decision"). After review of the currently listed patent term adjustment calculation in consideration of 35 USC 154(b)(1)(B) time, and after review of the Decision, Applicants hereby submit this Request for Reconsideration to correct the currently listed PTA calculation of 370 days.

Applicants believe the available PTA to be **511 days** based on the following facts:

1. The current PTA calculation incorrectly reflects the period of time between the three (3) year date of April 20, 2004 and the filing of the RCE dated November 22, 2004. The number of days within this period of time is 215 and not 74 as identified in the currently listed PTA calculation at number 187.5 (first item).
2. Applicants are only challenging the final calculation as per 37 CFR 1.705(d), however, provide all relevant dates as required under 1.703(a)-(e). Period of time being challenged is bolded within the below table for easy identification.

3. Applicants' are challenging the calculation for B Delays identified below. The subject three (3) year date is 04/20/2004. Between 04/20/2004 and the filing of a Request for Continued Examination on 11/22/2004, 215 days passed. This is a difference of 141 days.

Applicants' provide the following relevant dates during prosecution. These dates and PTA calculations are not being challenged as the application has already issued.

Prosecution Delays NOT BEING CHALLENGED			Delays	
#	Initial	Responsive	PTO	App
1	04/20/2001 Continued Prosecution Application filed	06/28/2001 Non-Final Action	0	0
2	06/28/2001 Non-Final Action	01/15/2002 Reply after Non-Final Action	0	109
3	01/15/2002 Reply after Non-Final Action	02/25/2002 Final Rejection	0	0
4	02/25/2002 Final Rejection	09/12/2003 Decision Granting Petition to Revive	0	472
5	02/25/2002 Final Rejection	07/14/2003 Notice of Appeal and Appeal Brief	0	415
6	07/14/2003 Notice of Appeal and Appeal Brief	12/01/2003 Non-Final Action	17	0
7	12/01/2003 Non-Final Action	02/27/2004 Reply After Non-Final Action	0	0
8	02/27/2004 Reply after Non-Final Action	05/18/2004 Final Rejection	0	0
9	05/18/2004 Final Rejection	11/22/2004 Request for Continued Examination	0	96
10	11/22/2004 Request for Continued Examination	02/24/2005 Non-Final Action	0	0
11	02/24/2005 Non-Final Action	05/27/2005 Reply After Non-Final Action	0	3
12	05/27/2005 Reply After Non-Final Action	08/11/2005 Final Rejection	0	0

Prosecution Delays NOT BEING CHALLENGED			Delays	
#	Initial	Responsive	PTO	App
13	08/11/2005 Final Rejection	02/09/2006 Notice of Appeal & Pre-Appeal Brief Request for Review	0	90
14	02/09/2006 Notice of Appeal & Pre-Appeal Brief Request for Review	09/19/2011 Final Board Decision – Reversed	2049	0
15	01/17/2007 Notice of Abandonment	07/18/2007 Petition to Revive – Granted	0	182
16	01/17/2007 Notice of Abandonment	10/10/2007 Notice Rescinding Abandonment	0	(182)
17	05/01/2007 Appeal Brief	10/16/2007 Examiner's Answer	45	0
18	09/19/2011 Final Board Decision – Reversed	01/12/2012 Notice of Allowance	0	0
19	01/12/2012 Notice of Allowance	04/10/2012 Payment of Issue Fee	0	0
20	04/10/2012 Payment of Issue Fee	05/08/2012 Issue Date	0	0
3-Year PTO to Issue Patent (B Delays)			Delays	
Initial		Responsive	PTO	App
04/20/2004 Three (3) Year Date		11/22/2004 Request for Continued Examination	215	0

USPTO Patent Term Adjustments as identified on Exhibit A are summarized as follows:

Type of Delay	Days	Corrected
A Delays – Row #6 above and line #59 on Exhibit A	17	17
B Delays - Line #187.5 on Exhibit A (36 Month Calculation)	74	215
C Delays – Row #14 above and line # 155 on Exhibit A	2049	2049
USPTO Total Delays	2140	2281
Minus Applicant Delays Identified in Exhibit A	(1770)	(1770)
	370	511

Applicants' are challenging the calculation for B Delays identified above. The subject three (3) year date is 04/20/2004. Between 04/20/2004 and the filing of a Request for Continued Examination on 11/22/2004, 215 days passed. This is a difference of 141 days. The currently listed PTA calculation is attached as Exhibit A. The present application is not subject to a terminal disclaimer.

In the Decision, the previously submitted petition to correct the patent term adjustment based on the above information was dismissed. Specifically, the previously issued Decision stated that “[t]he period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay.” Further, the Decision stated “[a]n appeal to the Board of Patent Appeals and Interferences commences with the filing of a notice of appeal.” Based on the above, the Decision alleged that the period beginning on July 14, 2003 (the date of filing of a notice of appeal in this application) and ending on December 1, 2003 (the date of mailing of a non-final Office Action in this application), a total of 141 days, should be excluded from B delay.

Applicants respectfully disagree with the Decision. Specifically, the Final Rule issued by the USPTO entitled “Revision of Patent Term Adjustment Provisions Related to Appellate Review,” (hereinafter, the “Final Rule”) states that “Section 1.703(b)(4), which defines the period of appellate review in 35 U.S.C. 154(b)(1)(B)(ii), is amended to define this period as the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Board under § 41.35(a) of this title” (77 FR 49,355 (2012-08-16)). Section 41.35(a), in turn, states that “[j]urisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.” However, in the immediate case, no Examiner's answer followed the notice of appeal filed on July 14, 2003. Accordingly, under the revised Section 1.703(b)(4), jurisdiction over the application was never passed to the Board, and therefore no period was consumed by appellate review. As such, Applicants respectfully submit that the period beginning on July 14, 2003 and ending on December 1, 2003 should not be excluded from calculation of B delay, as alleged in the Decision, and further submit that the proper B delay calculation is 215 days.

In addition, Applicants submit that submission of the immediate Request for Reconsideration of Patent Term Adjustment is timely. The Final Rule states that “[t]he Office will also apply the changes to § 1.703 in this final rule in any timely patent term adjustment reconsideration proceeding that is initiated on or after September 17, 2012. ... [S]uch patent

term adjustment reconsideration proceedings shall be the following timely filed proceedings initiated on or after September 17, 2012: ... (3) reconsideration proceedings initiated pursuant to a request for reconsideration that seeks reconsideration of the Office's decision under § 1.705(d) regarding patent term adjustment under the Office's former interpretation of the appellate review language of 35 U.S.C. 154(b)(1)(B)(ii) and (C)(iii), if such a request is filed within two months of the date of decision for which reconsideration is requested." This Request for Reconsideration is filed on September 17, 2012, within two months of the Decision mailed on August 15, 2012. Applicants therefore submit that the immediate request is timely.

Moreover, the Decision states that "[t]o the extent that [the Final Rule] revises the interpretation of appellate review applied in this decision, Patentee is given one (1) month or thirty (30) days, whichever is longer, from the date of the final rule to file a request for reconsideration." As noted above, the Decision was mailed on August 15, 2012. The one month period given in the decision therefore ends on Monday, September 17, 2012 (the first non-holiday following Saturday, September 15, 2012). Because the immediate Request for Reconsideration is filed on Monday, September 17, 2012, Applicants submit that the request is timely.

Based on the above, Applicants hereby request correction of the post issuance calculation of PTA to reflect 511 days.

The \$200 fee prescribed by 37 CFR 1.18(e) is enclosed for this application.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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Dated: 9/17/12